

**REMARKS/ARGUMENTS**

**35 U.S.C. §102 Rejection, Grapes**

The Office Action has rejected claims 1-3, 8 and 13-16 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,446,130 to Grapes (hereinafter "Grapes"). Applicants believe major limitations from claims 1, 8 and 14 are neither taught nor suggested in the Grapes reference. More specifically, Grapes cannot be relied on to teach or suggest: (1) "receiving a command *from the content distributor* to store the program at the user location" as required by claims 1, 8 and 14 or (2) "sending the program to the user location for storage *before* a user requests the program" as required by claim 8. Emphasis added.

Grapes is drawn to a multimedia delivery system that provides programs to users according to user input or requests. This reference does not teach or suggest that programs are stored at the user location by commands received *from* the content distributor. Furthermore, this reference does not teach or suggest that the content distributor sends the program to the user location *before* the user requests such program. Grapes merely teaches storing being performed based upon input solely from the user.

Despite the position taken in the final Office Action, Applicants believe the reference does not teach or suggest receiving commands *from* the content distributor to the user location, nor does it teach or suggest programs sent to user location *before* the user requests the programs. As best understood by the Applicant, the final Office Action takes the position that sending a program to a user is a command. Final Office Action, section 6, second paragraph. The argument continues to say, a user choosing to store that program (i.e., by their own free will) is the commanded storage. With all due respect, this is an unreasonable position. The claimed limitation is once again, "receiving a command *from the content distributor* to store the program at the user location." Reconsideration is respectfully requested for at least these reasons.

**35 U.S.C. §103 Rejection, Grapes in view of Satterfield**

The Office Action has rejected claims 4-6, 9, 12 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,446,130 to Grapes

(hereinafter "Grapes") in view of the cited portions of U.S. Patent No. 6,305,017 to Satterfield (hereinafter "Satterfield"). Beyond the argument above relating to Grapes not teaching receiving commands from the content distributor, the cited portions of Satterfield also do not teach receiving commands to store programs from the content distributor.

Further, motivation for the specific combination of elements is lacking. As best understood by the Applicant, the motivation to combine arguments in the Office Action follow a reasoning that if someone made the combination and/or substitution, the advantages would be self-evident. That is not the proper application of the test as the cited references themselves must teach or suggest the specific combination and/or substitution. To make the combination first can only be done by relying upon impermissible hindsight reconstruction using the claims as a template. Indeed, any surmised advantages stated in the Office Action for the claimed combination would help prove non-obviousness by way of the stated advantage tending to show fulfillment an unrecognized need (i.e., it would tend to show a secondary consideration is present).

No cite is made to a reference for a motivation to combine so the Applicants had assumed Official Notice was being relied upon in the last response. In the last paragraph of section 6 of the present Office Action, it is perplexingly made clear that no Official Notice is being relied upon. This being the case, Applicants respectfully posit that no *prima facie* case of obviousness has not been set forth since neither a cite to a reference nor Official Notice is used. Clarification and reconsideration of this rejection is respectfully requested.

**35 U.S.C. §103 Rejection, Grapes in view of Hall et al.**

The Office Action has rejected claims 7, 11 and 20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,446,130 to Grapes (hereinafter "Grapes") in view of the cited portions of U.S. Patent No. 5,920,861 to Hall et al. (hereinafter "Hall"). Claims 7, 11 and 20 are allowable for at least the reasons that their respective parent claims are. Further, a *prima facie* case for obviousness has not been set forth as there is no cite to a reference nor reliance any reliance on Official Notice.

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PATENT

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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